

REMARKS

New Claim 49

New claim 49 finds support in claim 2, where R_x , R_a and R_b , are further defined.

Restriction/Election

No evidence has been presented to support the restriction requirement. The subject matter of Group I is said to be classified in class 546, 519, subclasses 152, 180, 277.4, 277, 311, and 312 – 314 yet no evidence has been presented that the subject matter of Group II is classified elsewhere. Therefore the Examiner has not shown it would be an undue burden to expand the examination to additional compounds.

In the alternative to examining the full scope of the pending claims, Applicants submit that the definition of Group I should at least be expanded to include (a) other values for B found in claim 1; (b) other values for M found in claim 11; (c) other values for L found in claim 7 and (d) other values for L^1 found in claim 8. No evidence has been presented that it would be an undue burden to search any additional subject matter, let alone this subgenus of compounds. Furthermore, Applicants submit that since the subject matter of Group I has been examined prior to filing the Request for Continued Examination (RCE) and no art has been cited, it would not be an undue burden to expand the search to a subgenus of compounds which includes the definition of B found in claim 1, the definition of M found in claim 11, the definition L found in claim 7, and the definition of L^1 found in claim 8.

Applicants recognize that the search parameters used by the Examiner generated many hits. Applicants recommend that the Examiner's search include additional parameters of the claimed compounds such as, for example, one of the substituents required on L^1 , (SO_2R_x , $C(O)R_x$ and $C(NR_y)R_z$).

Claims 37, 39, 40, 42, 45 – 48 and new claim 49

Applicants' maintain that claims 37, 39, 40, 42, and 45- 48 define compounds that do not include

- groups for M other than O.
- groups for L other than phenyl, and
- groups for C¹ other than pyridiyl.

In addition, there is no evidence that claims 37- 48 encompass non-elected subject matter. Therefore, Applicants submit these claims are consistent with the election and should be allowed.

Rejection Under 35 U.S.C. § 112

Claim 2 does not contain the language objected to and further defines the individual substituents identified in claim 1 as the examiner suggests, such that the claim clearly satisfies the requirements of 35 U.S.C. §112, second paragraph. Claim 37 has similar definitions for the individual substituents which appear in claim 2. Claims 34 and 35 do not contain the language objected to and claims 17 - 19 have been amended to replace the language objected to. Therefore, claims 2, 17-19, 34, 35 and 37 clearly conform to the requirements of 35 U.S.C. §112, second paragraph.

Applicants also maintain that there is adequate written description for the subject matter defined by all claims including claims 1, 6 and 20 when the specification is considered as a whole. In view of the definitions of preferred values which appear in claim 2 together with the exemplified compounds, one of ordinary skill in the art would recognize that applicants have possession of compounds with such broadly defined substituents.

Scope of Enablement

The Examiner alleges that the specification does not provide any guidance as to the heterocyclic structures encompassed by the claims and that these heterocycles have different properties requiring undue experimentation to make and use them.

The specification provides both general and specific methods for making compounds consistent with formula I and both dosages and methods of administering these compounds are given within the specification. Some experimentation may be required to make and use compounds which have not been exemplified but there is no evidence this experimentation would be undue. In the absence of such evidence, all claims must be taken to satisfy the requirements of 35 U.S.C. § 112, first paragraph.

In addition, claims 2, 37, 39, 40, 42 and 45 - 48 define heterocyclic compounds substituted by only halogen, hydroxy or C₁ - C₁₀ alkyl and claims 17 - 19 and 49 do not include the language objected to. Therefore, these claims clearly satisfy the statute. No evidence has been presented to the contrary.

Rejection Under 35 U.S.C. § 112, second paragraph

Applicants maintain the functional language used in the claims to define the cancers to be treated together with the detailed disclosure provides sufficient guidance to one skill in the art to determine what particular cancers are treatable.

Double Patenting

Applicants submit the double patenting rejection is inconsistent with the restriction requirement made in this application and also premature in that allowable subject matter has not been identified.

Based on the above remarks, applicants submit that the examination of all claimed subject should continue, and that at least the claims which conform to the elected subject matter, i.e., claims 37-49, are in condition for allowance.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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